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SEP 06 2006

Customer No.: 31561
Application No.: 10/604,131
Docket No.: 10461-US-PA**REMARKS**

This is a full and timely response to the outstanding Final Office Action mailed June 13, 2006. Applicants submit that claims 2 and 3 have been canceled hereby, while the other claims remain unchanged as previously presented. Reconsideration and allowance of the application and presently pending claims 1-11 are respectfully requested.

Discussion of the Claim Objections and the Current Final Status

Claims 2 and 3 are objected to under 37 CFR 1.75(c), as being improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants have canceled claims 2 and 3 hereby, and thus the claim objections are moot.

Applicants note the Examiner contended that "the limitations of claims 2 and 3 are fully covered by the limitations amended to claim 1 and do not further limit the parent claim" (Page 2 of the current Office Action). Applicants further submit that the limitations previously amended to claim 1 are fully supported by claims 2 and 3 as originally filed. As such, Applicants submit that the previous amendment to claim 1 should not have necessitated the new ground of rejection presented in this Office Action (MPEP §706.07). The final status of this rejection is requested to be withdrawn, and if the rejection is to be sustained, a new nonfinal Office Action is respectfully solicited hereby.

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Docket No.: 10461-US-PA**Claim Rejections – 35 U.S.C. § 103**

The Office Action rejected claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over Dutta US 20020163524 in view of Adelson et al. US 3,530,312, hereinafter Adelson, and further in view of Metroka et al. (USPN: 48457720), hereinafter Metroka.

With respect to claim 1, as currently amended, recites in part:

A hand-held apparatus ... comprising:

... when the metal slice is touched by a user, the display is turned on and the on state is maintained until the metal slice is touched again (Emphasis added)

Applicants submit that such a hand-held apparatus as set forth in claim 1, as currently amended, is neither taught, disclosed, nor suggested by Dutta, Adelson, or even when modified by Metroka, or any of the other cited references, taken alone or in combination.

Applicants have previously amended claim 1 to include subject matters of originally filed claims 2 and 3. Applicants note that the Examiner has admitted that "neither Adelson nor Dutta disclose 'wherein when the metal slice is touched by a user, the display is turned on and the on state is maintained until the metal slice is touched again'". In response to the amendment made to claim 1, the Examiner further recited Metroka to modify the previously proposed combination

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of Dutta and Adelson to render the hand-held apparatus, as set forth in claim 1, as previously presented, *prima facie* obvious.

The Examiner contended that "Metroka discloses a portable telephone utilizing a momentary switch for turning the power to the portable telephone on and off (col. lines 55-57)" and "the device operates in an on state until the portable telephone is open and the momentary switch is pressed again (Fig. 10; col. 7, lines 6-19)".

Applicants submit that a momentary switch for turning the power of the entire device of a portable phone on and off as taught by Metroka, does not read on a metal slice for maintaining state of a **display of a hand-held apparatus** until the metal slice is touched again as required by the present invention as set forth in claim 1. Note, the portable telephone of Metroka even does not contain any display device for being switched on and off, while the momentary switch controls the power supply of the entire portable telephone device rather than a part thereof only. Such a momentary switch of Metroka, however, as concluded right after the foregoing cited descriptions, addresses "the capability of ignoring spurious control switch inputs" (col. 7, lines 20-21).

The Examiner construed the momentary switch of Metroka as an on/off technique and gave a motivation for using the on/off techniques of Metroka to provide a device that could be turned on and maintain the on state until a user desired to turn it off. Applicants find no such teachings throughout Metroka, while a major object of Metroka is clearly disclosed as being to prevent unwanted operation of dial and control button mechanism. Applicants submit that when

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applying 35 U.S.C. 103 rejections, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention (MPEP §2141).

When considered as a whole, the cited references give no teachings to provide "a hand-held apparatus ... wherein when the metal slice touched by a user, the display is turned on and the on state is maintained until the metal slice is touched again" (Emphasis added). Applicants submit that without any sound and reasonable motivations, desirability provided by the cited references, the combination with Metroka takes benefit of impermissible hindsight.

As such, the present hand-held apparatus, as set forth in claim 1, as previously presented, is submitted to be novel and unobvious over Adelson, Dutta, Metroka, or any of the other cited references, taken alone or in combination, and thus should be allowed.

If independent claim 1 is allowable over the prior art of record, then its dependent claims 4-11 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1, and 4-11 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Date : *Sept. 6, 2006*

Respectfully submitted,

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